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| APPLICATION NO.                  | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|----------------------------------|-------------|----------------------|---------------------|------------------|
| 10/786,995                       | 02/25/2004  | Carl R. Vanderschuit | 9053-000119US       | 6784             |
| 28997                            | 7590        | 01/25/2006           | EXAMINER            |                  |
| HARNESS, DICKEY, & PIERCE, P.L.C |             |                      | HAN, JASON          |                  |
| 7700 BONHOMME, STE 400           |             |                      | ART UNIT            |                  |
| ST. LOUIS, MO 63105              |             |                      | PAPER NUMBER        |                  |
|                                  |             |                      | 2875                |                  |

DATE MAILED: 01/25/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                               |                                       |  |
|------------------------------|-------------------------------|---------------------------------------|--|
| <b>Office Action Summary</b> | Application No.<br>10/786,995 | Applicant(s)<br>VANDERSCHUIT, CARL R. |  |
|                              | Examiner<br>Jason M. Han      | Art Unit<br>2875                      |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 08 November 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-14, 18-24, 35-38 and 46-54 is/are pending in the application.
- 4a) Of the above claim(s) 46 and 47 is/are withdrawn from consideration.
- 5) ☒ Claim(s) 21-24, 38 and 52-54 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 5-10, 12-14, 19, 20 and 35-37 is/are rejected.
- 7) ☒ Claim(s) 3, 4, 11, 18 and 48-51 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 25 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date. _____  | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on November 8, 2005 has been entered.

### ***Response to Arguments***

2. Applicant's arguments with respect to Claims 1-14, 18-24, and 35-38 have been considered but are moot in view of the new ground(s) of rejection.

3. Applicant's argument with respect to Claims 46-47 have been considered, but remain restricted, since Claims 46-47 are considered a separate and distinct species of the present invention as described below.

### ***Election/Restrictions***

4. Newly submitted Claims 46-47, filed June 6, 2006, are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claims 46-47 are distinct from the present invention in that no recitation is provided for holding the light source member within a pocket, but rather through friction fitting with a central opening sized to receive the light source member.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

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prosecution on the merits. Accordingly, Claims 46-47 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-2 and 5-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Publication 2004/0039428).
6. With regards to Claim 1, Williams discloses a therapeutic device including:
  - A container [Figure 3: (2)] having a pocket [Figure 3: (15)] on an outer surface thereof;
  - A hot/cold gel [Paragraphs 32 and 39] contained within the container; and
  - A member [Figure 3: (4)] removably positioned within the pocket, wherein the member has at least one light source capable of emitting therapeutic light [Paragraph 9].

Williams does not specifically teach the hot/cold gel being hermetically sealed within the container, however, it is obvious that one would want a hermetically sealed container in order to ensure appropriate containment of the gel.

Lastly, though Williams does not specifically teach the method of applying the therapeutic device to a user's body to perform at least one of heat therapy, cold therapy,

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and therapeutic light, it has been held an obvious matter that one could implement a method claim of use when all structural limitations of the device have been addressed by the prior art.

7. With regards to Claim 2, Williams discloses the claimed invention as cited above.

In addition, it is obvious that Williams could simultaneously apply therapeutic light [Paragraph 32] and one of heat and cold therapy to a user's body [Paragraph 39].

8. With regard to Claims 5-6, Williams discloses the claimed invention as cited above. In addition, it is obvious that Williams could remove the light source from the pocket [Paragraph 31], heat (re: Claim 5) or cool (re: Claim 6) the hot/cold gel within the container, and reposition the member having the light source within the pocket prior to applying the therapeutic device to the user's body.

9. With regards to Claim 7, Williams discloses the claimed invention as cited above.

In addition, Williams teaches activating the light source to apply therapeutic light to the user's body [Paragraph 4].

10. With regards to Claim 8, Williams discloses the claimed invention as cited above.

In addition, Williams teaches the device including an attachment device [Figure 10: (44)], whereby the therapeutic device may be applied to a user's body via using the attachment device to attach said device to the user's body [Paragraph 38].

11. Claims 9-10, 14, and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Publication 2004/0039428).

12. With regards to Claim 9, Williams discloses a therapeutic device including:

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- A container [Figure 3: (2)] having a pocket [Figure 3: (15)] on an outer surface thereof;
- A non-electrical agent [Paragraphs 32 and 39] contained within the container for applying one of hot and cold therapies; and
- A member [Figure 3: (4)] sized to be positioned within the pocket, wherein the member has at least one light source capable of emitting therapeutic light [Paragraph 9].

Williams does not specifically teach the hot/cold gel being hermetically sealed within the container, however, it is obvious that one would want a hermetically sealed container in order to ensure appropriate containment of the gel.

13. With regards to Claim 10, Williams discloses the claimed invention as cited above. In addition, Williams teaches the non-electrical agent including hot/cold gel Paragraphs 32 and 39].

14. With regards to Claim 14, Williams discloses the claimed invention as cited above. In addition, Williams teaches the light source including a plurality of light emitting diodes [Paragraph 29].

15. With regards to Claim 19, Williams discloses the claimed invention as cited above. In addition, Williams teaches the device including an attachment device [Figure 10: (44)] for attaching said device to a user's body [Paragraph 38].

16. Claims 12-13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Publication 2004/0039428) as applied to Claim 9 above, and further in view of Altshuler et al. (U.S. Publication 2004/0093042).

Williams discloses the claimed invention as cited above, but does not specifically teach the light source emitting infrared or near infrared light (re: Claim 12), nor said light source emitting light having a wavelength within a range of about 680 nanometers and about 880 nanometers (re: Claim 13).

Altshuler teaches, "Energy source 1 may produce electromagnetic radiation, such as near infrared or visibly light radiation over a broad spectrum, over a limited spectrum or at a single wavelength, such as would be produced by a light emitting diode or a laser [Page 4, Paragraph 45]." In addition, Altshuler teaches a light source that emits light having a wavelength of about 680 nanometers, as well as about 880 nanometers, depending upon certain depths of tissue and the desired therapeutic effect [Claims 10-11; Table 1].

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the therapeutic device of Williams to incorporate the infrared or near infrared (as well as a light emission range of 680 to 880 nanometers) light source of Altshuler in order to enhance therapeutic effect on a user, whereby it has been found that the modulation of infrared energy at relatively low frequencies, typically in the sonic or sub-sonic range, can provide improved remedial effects for an IR therapy device.

17. Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Publication 2004/0039428) as applied to Claim 19 above, and further in view of Prescott (U.S. Patent 5616140).

Williams discloses the claimed invention as cited above, but does not specifically teach the attachment device including an adhesive bandage strip coupled to the container.

Prescott teaches a container [Figure 6: (610)] including an adhesive strip to attach to a user's body [Column 12, Lines 1-4].

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the therapeutic device of Williams, and more specifically the attachment device, to incorporate the adhesive strip of Prescott to ensure a strong connection between the device and user's body.

18. Claim 35 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Publication 2004/0039428) as applied to Claim 1 above, and further in view of Altshuler et al. (U.S. Publication 2004/0093042).

Williams discloses the claimed invention as cited above, but does not specifically teach the light emitting diodes producing light at two or more different wavelengths including 680 nanometers, 730 nanometers, and 880 nanometers.

Altshuler teaches, "said source is at least primarily at one or more wavelengths between about 600 nm and about 1850 nm [Claim 10]."

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the therapeutic device of Williams to incorporate the light emitting diodes to selectively emit light at wavelengths of 680, 730, and/or 880 nanometers, as taught by Altshuler, so as to enhance therapeutic effect on a user, whereby, "Certain



wavelengths may be preferentially absorbed by the tissue to be treated [see Altshuler: Page 4, Paragraph 47].”

19. Claim 36 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Publication 2004/0039428) as applied to Claim 9 above, and further in view of Yamashita et al. (U.S. Patent 3976049).

Williams discloses the claimed invention as cited above, but does not specifically teach the device being packaged in a vacuum-sealed package, and wherein the non-electrical agent is configured to generate one of heat or cold when the package is opened thereby exposing the device to air.

Yamashita teaches, “In the structure of the warmer of the present invention, when the sealing part 19 of the air-tight envelope 15 provided with a sealing means is released, an opening part 18 is opened and the warmer T is taken out, outside air flows in the heat-generating composition 10 through aeration holes 17 for the composition and inner bag 11 inside the warmer T, and heat-generation is immediately initiated. When interruption of heat-generation is desired, all that is required is to return the contents into the air-tight envelope [Column 6, Lines 9-19].”

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the therapeutic device of Williams to incorporate the heat-generation means via air exposure, as taught by Yamashita, in order to provide a controlled means for generating heat for the therapeutic device as desired by a user.

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20. Claim 37 is rejected under 35 U.S.C. 103(a) as being unpatentable over Williams et al. (U.S. Publication 2004/0039428) as applied to Claim 9 above, and further in view of Altshuler et al. (U.S. Publication 2004/0093042).

Williams discloses the claimed invention as cited above, but does not specifically teach the light emitting diodes producing light at two or more different wavelengths including 680 nanometers, 730 nanometers, and 880 nanometers.

Altshuler teaches, "said source is at least primarily at one or more wavelengths between about 600 nm and about 1850 nm [Claim 10]."

It would have been obvious to one ordinarily skilled in the art at the time of invention to modify the therapeutic device of Williams to incorporate the light emitting diodes to selectively emit light at wavelengths of 680, 730, and/or 880 nanometers, as taught by Altshuler, so as to enhance therapeutic effect on a user, whereby, "Certain wavelengths may be preferentially absorbed by the tissue to be treated [see Altshuler: Page 4, Paragraph 47]."

#### ***Allowable Subject Matter***

21. Claims 3-4 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Dependent Claim 3 recites subject matter concerning a massager, whereby the prior art of record fails to teach or suggest the combination of a massager within a

therapeutic device incorporating phototherapy and one of heat or cold therapy to a user's body.

22. Claim 11 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Dependent Claim 11 recites subject matter concerning a massager, whereby the prior art of record fails to teach or suggest the combination of a massager within a therapeutic device incorporating phototherapy and one of heat or cold therapy to a user's body.

23. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Dependent Claim 18 recites subject matter concerning a flexible switch member that connects the light source to a power source. The prior art of record fails to teach or suggest the combination of a flexible switch member that connects a light source to a power source within a therapeutic device incorporating phototherapy and one of heat or cold therapy to a user's body.

24. Claims 48-49 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

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The following is a statement of reasons for the indication of allowable subject matter: Dependent Claim 48 recites subject matter concerning a flexible switch member that connects the light source to a power source. The prior art of record fails to teach or suggest the combination of a flexible switch member that connects a light source to a power source within a therapeutic device incorporating phototherapy and one of heat or cold therapy to a user's body.

25. Claims 50-51 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter: Dependent Claim 50 recites subject matter concerning a flexible switch member that connects the light source to a power source. The prior art of record fails to teach or suggest the combination of a flexible switch member that connects a light source to a power source within a therapeutic device incorporating phototherapy and one of heat or cold therapy to a user's body.

26. Claims 21-24, 38, and 52 are allowed.

The following is an examiner's statement of reasons for allowance: With regards to Independent Claim 21, the Applicant has sufficiently amended and narrowly defined a therapeutic device including a flexible switch member that connects a light source to a power source. The prior art of record fails to teach or suggest the combination of a flexible switch member that connects a light source to a power source within a

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therapeutic device incorporating phototherapy and one of heat or cold therapy to a user's body, and all subsequent dependent claims are allowed.

27. Claims 53-54 are allowed.

The following is an examiner's statement of reasons for allowance: With regards to Independent Claim 52, the Applicant has sufficiently amended and narrowly defined a therapeutic device including a flexible switch member that connects a light source to a power source. The prior art of record fails to teach or suggest the combination of a flexible switch member that connects a light source to a power source within a therapeutic device incorporating phototherapy and one of heat or cold therapy to a user's body, and all subsequent dependent claims are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

### ***Conclusion***


Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason M. Han whose telephone number is (571) 272-2207. The examiner can normally be reached on 8:00am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sandra O'Shea can be reached on (571) 272-2378. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

JMH (1/13/2006)



ALAN CARIASO  
PRIMARY EXAMINER